Remarks

This amendment is submitted in response to the Office Action mailed 27 September 2005, in connection with the above-identified application (hereinafter, the "Office Action"). The Office Action provided a three-month shortened statutory period in which to respond, ending on 27 December 2005. Submitted herewith is a Petition for a Three-Month Extension of Time extending the due date to 27 March 2006. Accordingly, this amendment is timely submitted.

Claims 1 through 24 are currently pending. Applicant respectfully requests the entry of the amendments to claim 1 and claim 10, and the cancellation of claim 9 without prejudice. Applicant respectfully submits that the amendments to the pending claim does not introduce new matter. More specifically, the basis for the amendment to claim can be found in claim 10 and the specification of the application as published.

Claims rejections under 35-USC §112

The Examiner has rejected claims 1-24 under 35-USC §112, first paragraph. Although Applicant believes that "wherein said fruit juice is not specially processed" would be apparent and easily understood by those of ordinary skill in the art, Applicant believes this rejection to be now moot based on the amendment of claim 1 presented in this application.

Claims rejections under 35-USC §102(b)

The Examiner has rejected claims 1-9, 11-20 and 22-24 under 35-USC §102(b) as being anticipated by Liebrecht, et al. (United States Patent Number 6,106,874). Liebrecht relates to a beverage as a source of calcium (abstract). Liebrecht ('874) specifically uses a depectinized fruit juice (abstract, specification and claim 1) which would require "special" processing, therefore, Applicant respectfully disagrees with the Examiner's statement on page 4 of the present Office Action, to the contrary. The present invention as now claimed in claim 1 claims as an element "a source of protein in an amount from about 0.5 to about 10 wt % of the composition, wherein the protein source is a combination of whey protein isolate and whey protein hydrolysate". A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 31USPQ2d 1671 (Fed Cir. 1994). As admitted by the Examiner, Liebrecht does not disclose the use of whey protein hydrosylates. Thus, in view of the foregoing arguments, Applicant respectfully requests that these rejections under 35 U.S.C. §102(b) be withdrawn.

Claims rejections under 35-USC §103

The Examiner has rejected Claim 10 under 35 USC §103 Liebrecht in view of Burke (GB 2335134A). As admitted by the Examiner, Liebrecht does not disclose the use of whey protein hydrosylates.

Applicants respectfully submit that this rejection is improper because a prima facie case of obviousness has not been established. The three elements of a prima facie case of obviousness are: 1) some suggestion or motivation to modify the reference or combine the teachings; 2) a reasonable expectation of success and 3) the prior art references must teach or suggest all the claim limitations. Fine 837 F.2d 1071 (Fed.Cir 1988), In re Jones 958 F.2d 347 (Fed.Cir 1992). Burke relates to a carbonated sports drink of high caloric value people engaged in physical activities, and Liebrecht is specifically for providing calcium supplementation. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990). Neither reference suggests the desirability of the combination since their intended uses are dramatically varied.

Turning now to the second element of obviousness, there is no reasonable expectation of success. Contrary to a reasonable expectation of success, Burke states that protein hydrosylates have a problem that they tend to precipitate (page 3, lines 22-28), and thus need specific levels of specific carbohydrates to prevent this precipitation. Further in the present application in ¶ 5 it describes that "The development of fruit juice based beverages containing proteins, carbohydrates, vitamins, and minerals is very difficult. The interaction of the ingredients, particularly the protein with the minerals and other ingredients, often cause the protein to precipitate and frequently cause the entire composition to become very viscous or to gel. Similarly, these interactions may change the physical or chemical properties of the composition in a way that adversely affects the taste, color, odor, mouth-feel and other physical properties of the composition. These adverse changes may occur at any time but are particularly likely when the composition is heated during processing or when the composition sits on the shelf for extended periods. The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success. In re Merck & Co., Inc., 231 USPQ 375 (Fed. Cir. 1986); MPEP 2143.02, in this case there is no reasonable expectation of success. Neither reference teaches or suggests that the addition of protein hydrosylates will illicit a clear beverage and not cause the problems of precipitation when added to a composition as described in the present invention. Additionally, the Examiner has not addressed this element is his responses.

As the Examiner has stated in the 27 September 2005 Office Action, "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 108

USPQ 871, 881 (CCPA 1981). Applicant submits that the teachings of Liebrecht, a calcium supplement, and Burke, a carbonated sports beverage, would not have suggested to those of ordinary skill in the art to be combined, and the problems elucidated in Burke of precipitation, taste, color, odor, mouth-feel and other physical properties of the composition, would not have been solved, and would have made the combination unobvious to those of ordinary skill in the art.

Even if Liebrecht and Burke were to be combined, the solution proposed by Applicant would not be achieved since they still would not teach how to combine the ratio of ingredients claimed in Claim 1, nor a clear, palatable beverage, without precipitate of the protein.

Thus, in view of the foregoing arguments, Applicant respectfully requests that these rejections under 35 U.S.C. §103 be withdrawn.

Applicant respectfully requests reconsideration of the present application. If a telephone interview would be of assistance in advancing the prosecution of the application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Respectfully submitted,

Novartis
Corporate Intellectual Property
One Health Plaza, Building 430
East Hanover, NJ 07936-1080
(862) 778-7954

Gary M. Lobel
Attorney for Applicants
Reg. No. 51,155

Date: 27 March 2006